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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
KYLE, CHARLES R

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,951

Applicant(s)

COLE ET AL.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4, 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 11-12 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claim 9, it recites that a data conversion processor comprises a series of method steps, which make the nature of the claimed invention unclear.

With respect to Claim 11, it recites that a reconciliation conversion processor comprises a series of method steps, which make the nature of the claimed invention unclear. Further, it recites the phrase “using tie-breaker rules when said matching algorithm returns more than one or more market valuations”. This is confusing; an algorithm should return only one result. It would be sensible for results of two or more algorithms to require a tiebreaker, but not one. The phrase “returns more than one or more market valuations” is confusing. Finally, the use of the word “using” is vague, in that it is not clear how algorithms and tiebreakers are used.

With respect to Claim 24, it recites the phrase “using tie-breaker rules when said matching algorithm returns more than one or more market valuations”. This is confusing; an algorithm should return only one result. It would be sensible for results of two or more algorithms to require a tiebreaker, but not one. Finally, the use of the word “using” is vague, in that it is not clear how algorithms and tiebreakers are used. The phrase “returns more than one or more market valuations” is confusing.

Concerning Claims 12 and 25, they recite the phrases “said real-time world-wide market value”, “said user specified decision criteria for valuing said financial transaction” and “said user specified decision criteria for reconciling ...”. These lack antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-23, 25-31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,802,499 *Sampson et al* in view of US 6,205,452 *Warmus et al*, both already of record.

Concerning Claim 1, *Sampson* discloses the invention substantially as claimed, including in a platform-independent method of collateral matching and mark to market reconciliation using a global communications network (Summary of the Invention), the steps of:

Accessing said global communications network (Col. 4, lines 8-21);

Transmitting financial transaction data, wherein said financial transaction data comprises financial data and user instructional data (Col. 11, lines 28-67);

Inputting said financial transaction data using a standard format (Col. 4, lines 47-50);

Comparing a first set of financial transaction data with a second set of financial transaction data to determine a collateral match decision (Col. 4, line 60 to Col. 5, line 14);

20 Retrieving mark to market parameters for said financial transaction data associated with said collateral match decision (Fig. 5B; Col. 22, lines 4-8);

Using said mark to market parameters to calculate a market value for said financial transaction data associated with said matched decision (Col. 1, lines 40-57); and

Providing useful reports (Col. 9, lines 39-60).

Sampson does not specifically disclose conversion of financial data to a standard format. *Warmus* discloses conversion of data to a standard format at Col. 8, lines 29-33. Also see *Warmus* at top of page, Cols. 13-14 , Table.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collateral matching and mark to market reconciliation method of *Sampson* to use the data format conversions disclosed by *Warmus* because this would have provided rapid and flexible manipulation of financial data provided to users. This desirability of such manipulation is specifically set out in *Warmus* at Background of the Invention.

With respect to Claim 2, *Sampson* discloses mark to market value associated with a financial transaction at Col. 1, lines 40-67.

As to Claim 3, *Sampson* discloses real-time function at Col. 2, lines 7-11 and worldwide function at Col. 8, lines 56-67. *Sampson* does not specifically disclose worldwide market values.

Official Notice is taken that the use of worldwide market values for worldwide financial activity is old and well known in the financial arts. For example, in currency trading, market values are driven to a common worldwide valuation for each currency.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Sampson* to use world wide market values of financial transactions because this would have provided the most realistic valuation of asset values in a liquid, rapidly changing global market.

Concerning Claim 4, *Sampson* discloses auditing of financial data at Col. 8, lines 5-10. Managing/administering such data is disclosed at Col. 1, lines 5-10 and Col. 2, lines 28-43, at least.

Concerning Claim 5, see the discussion of Claim 6 below. Application of the steps to an import of financial data would provide allow for acceptance of data of variable format.

Concerning Claim 6, *Sampson* does not specifically disclose templates, export and specification creation. *Warmus* discloses a template for data export (Col. 4, lines 4-6), exporting data (Col. 4, line 7-14) and export specification creations (Col. 4, line 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Sampson* to include these features so as to export data according to variable parameters in an export specification. As to generation of a unique export specification code, it is read as a version identifier used to infer data export characteristics.

Concerning Claims 7, 8 and 10, *Sampson* discloses a processor for performing the method of the invention at Col. 9, line 1 to col. 10, line 19. Applicants' claims recite mark to market, data conversion and reconciliation processors. Each of these processors is at some time

instantiated in the processor disclosed by *Sampson*, because at the particular instant in which one of these functions is performed, the state of the processor is that of a marking, conversion or reconciliation machine. Applicants' claims recite no step providing a novel or unobvious arrangement of particular elements.

Note that *Sampson* specifically discloses reconciliation at Col. 24, line 59 to Col. 25, line 44.

With respect to Claim 9, see the discussion of Claim 1. *Sampson* does not specifically disclose the steps recited in claim 9. These steps are common database file format manipulations used to perform data conversions. *Warmus* discloses these steps as follows:

Managing a data file from a user (Summary of the Invention);

Converting data files to a standard file format (Col. 8, lines 29-33);

Parsing a data file (Col. 22, lines 25-34);

Validating a data file (Col. 34, lines 64-66);

Converting a data field to a standard format (Col. 12, lines 47-56);

Mapping (Col. 45, lines 64-67) and standardized, populated data field according to user preferences (Col. 12, lines 62-67);

Creating and reconfiguring export specifications (Col. 29, line 58 to Col. 31, line 44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the financial reporting method of *Sampson* through the use of database file format manipulations of *Warmus* because this would have provided for varying output formats

required by different persons to whom data was exported. Such variable formatting would make the method appealing to a greater number of financial parties.

Sampson does not specifically disclose creating and reconfiguring import specifications. For reasons similar to those above regarding export specifications, it would have been obvious to have flexible import specifications to make the method acceptable and usable to more persons.

Further, Official Notice is taken that blank or zero-filling for empty data fields was old and well known. The use of this feature with *Sampson* would be obvious to provide “placeholders” in a fixed format file. Additionally, logging errors would have been obvious to allow for problem diagnosis.

Concerning Claim 12, *Sampson* discloses a collateral match decision report at Col. 11, lines 10-67.

As to Claim 13, *Sampson* discloses controlling a communications path among multiple users at Col. 9, lines 1-60.

With respect to Claims 14-23 and 25-26, they are the system forms of Claims 1-10 and 12-13 and are rejected in a like manner.

With respect to Claim 27, see the discussion of Claim 1. *Sampson* further discloses data manipulation steps of displaying a user module (Co. 5, lines 7-11), viewing (Col. 4, lines 42-59), selecting (Col. 40, lines 23-25), transmitting (Col. 84, line 21), translating (Col. 2, lines 11-16), authenticating (Col. 9, line 5) and storing (Abstract).

Concerning Claim 28, see the discussions of Claims 27, 4 and 13.

With respect to Claims 29 and 30, they are the system forms of Claims 27-28 and are rejected in a like manner.

Concerning Claim 31, see the discussions above and *Sampson* further discloses a communications network having a plurality of users and a plurality of client terminals at Fig. 1.

Concerning Claim 34, *Sampson* does not specifically disclose that the communications network is owned by the financial institution.

Official Notice is taken that network ownership by financial institutions is old and well known in financial arts. For example, NASDAQ owns a private network for financial transactions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the financial institution to own its network because this would have provided economies and security.

Claims 11 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,802,499 *Sampson et al* in view of US 6,205,452 *Warmus et al* and further in view of US 6,385,602 *Tso et al*.

As to Claim 11, see the discussion of Claims 1 and 10 above. *Sampson* does not specifically disclose prioritizing matching algorithms for financial transactions and using tiebreaker rules. *Tso* discloses matching algorithms (Background of the Invention) and prioritizing of these by users and use of tiebreakers at Col. 7, line 59 to Col. 8, line 5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have

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modified the method of *Sampson* with the additional features of *Tso* because this would have provided a most suitable selection of collateral matching items.

With respect to Claim 24, it is the system form of Claim 11 and is rejected in a like manner.

Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,802,499 *Sampson et al* in view of US 6,205,452 *Warmus et al* and further in view of US 6,016,484 *Williams et al*.

With respect to Claim 32, see the discussion of Claim 31. *Sampson* does not specifically disclose an interactive user module comprising an application downloaded from a network. *Williams* discloses these features at Col. 12, lines 36-38 and Col. 9, lines 34-44. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the web-based downloadable application modules disclosed by *Williams* in the system of *Sampson* because this would have provided convenient access to the collateral matching and mark to market functionality of *Sampson*.

With respect to Claim 33, *Williams* further discloses use of the Internet at Col. 9, lines 34-44. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Internet as disclosed by *Williams* in the system of *Sampson* because this would have provided broad and inexpensive access to the collateral matching and mark to market functionality of *Sampson*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Charles Kyle



crk
February 26, 2004